

REMARKS

In response to the restriction requirement, the applicants provisionally elect to prosecute the claims identified as being associated with Group I, namely, claims 1-26. However, applicants respectfully submit that the restriction requirement is improper on its face because it does not meet the requirement that a search and examination of the entire application must be a serious burden on the examiner and because the examiner has not shown that the identified inventions have separate utility.

M.P.E.P. §803 states:

“If the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions.”

Applicants respectfully submit that a search of all of the claims within Groups I – V would not be a burden, much less a serious burden, on the examiner in this case. In fact, a thorough search of the system of claims 1-26 will necessitate a search of the systems and methods recited in the other groups of claims. The subject matter of claims 27-107 is not so materially different from that of claims 1-26 to make searching of all of these claims together a serious burden. In particular, each of the pending claims requires obtaining data from an economic data source and a process plant or control data source, using these two types of data in a model to model the operation of some component or part of a process plant and using the output of the model for some purpose related to the process plant. Applicants therefore traverse the restriction requirement on the ground that there is no evidence in the Office Action, or even an allegation, that search and examination of the entire application would be a serious burden on the examiner, as required by M.P.E.P. §803. In fact, applicants respectfully submit that a complete search directed to the subject matter of the claims of Group I would require a search directed to the subject matter of the claims of Groups II-V, and vice versa. Merely identifying alleged different classifications of claims and pointing to alleged different utilities for the different independent claims does not establish the existence of a serious burden.

Moreover, while the examiner has alleged that the different groups of claims have separate utilities, the examiner has failed to provide any specific evidence of this condition. In particular, the examiner has merely pointed to a different possible utility for each of the different groups of claims without showing how the identified “utilities” are not applicable to every group of claim. That is, the examiner ignores the fact that, in many if not all cases, the invention recited by a particular group of claims has the same utility the examiner provides for each of the other groups of claims. That is, the examiner has not indicated how the different groups of claims have *separate* utilities, because the utilities pointed to by the examiner are, in most cases, common to each of the identified groups of claims. Thus, for example, the invention recited by claim 1 (Group I) can be used to involve in the process control system “a maintenance person, a process control operator or a business person” (the alleged utility of Group II), to provide an ”output to a process control application, such as an optimizer application, an on-line-control routine, a control display application and an alarm generation application” (the alleged utility of Group III), to provide a “user interface that allows a user to quickly and easily examine a particular process or a process run” (the alleged utility of Group IV), and to provide “data for the control of the plant or for using in applications not directly associated with the control of the plant” (the alleged utility of Group V). In a similar manner, each of the inventions of Groups II-V can be used to facilitate “the monitoring of the implementation of a process control system” (the alleged utility of Group I). There is nothing inherent in the limitations of claim 1 that prevents the invention of claim 1 from having the utility identified for each of the other groups of claims, nor is there any limitation in independent claims 27, 42, 57 and 82 which prevents these inventions from being used in the manner identified by the examiner as the utility of Group I. Thus, applicants submit that the examiner has failed to show the inventions of the different sets of claims have *separate* utilities as required under M.P.E.P. §806.05(d).

Because search and examination of the application can be made without a serious burden on the examiner (and the Patent Office has not stated otherwise) and because the examiner has failed to meet the burden of showing separate utilities for the different groups of claims, it would be wasteful of the time, effort, and resources of both the applicants and the Patent Office to prosecute the different sets of claims in separate applications. Search and

examination of the identified groups of claims together would be much more efficient than requiring the Patent Office and the applicants to do so separately in multiple applications.

This paper is being filed within the one month shortened statutory period for reply and, therefore, no fee is due. However, the Commissioner is hereby authorized to charge any additional fees or to credit any overpayments to Deposit Account No. 13-2855 of Marshall, Gerstein & Borun LLP.

Dated: July 30, 2008

Respectfully submitted,

By 
Roger A. Heppermann
Registration No.: 37,641
MARSHALL, GERSTEIN & BORUN LLP
233 S. Wacker Drive, Suite 6300
Sears Tower
Chicago, Illinois 60606-6357
(312) 474-6300
Attorney for Applicants